

### **REMARKS**

Favorable reconsideration and allowance of the present application is respectfully requested.

As an initial matter, it was noted in the Office Action that numerous references were cited in an IDS filed on July 15, 2002, but no PTOL-1449 was provided. However, Applicants mailed the "Information Disclosure Statement List" listing 122 references via First Class Mail on July 12, 2002. For the Examiner's convenience, the previously submitted Information Disclosure List and a postcard stamped by the USTPO are enclosed herewith as Appendix A. Applicants note that copies of each of the cited 122 references were properly submitted on July 12, 2002, and thus are not being re-submitted herewith. In addition, because the Information Disclosure List was properly filed prior to the first substantive Office Action, Applicants also respectfully submit that no fees are due.

Claims 1-15 are currently pending in the present application, including independent claims 1 and 10. Independent claim 1, for instance, is directed to a disposable shoe liner comprising a laminate structure shaped to approximate the contours of a foot. The laminate structure comprises a first substrate containing a thermoplastic polymer and a second substrate containing a thermoplastic polymer. At least one of the substrates comprises a nonwoven web. Further, the thermoplastic polymer of the first substrate is fused together with the thermoplastic polymer of the second substrate to form fused portions and unfused portions located between the fused portions. The unfused portions define pockets containing discrete regions of a functional material that is capable of providing comfort to the foot of a user.

In the Office Action, claims 1-15 were provisionally rejected under the judicially created doctrine of obvious-type double patenting in view of claims 1-24 of U.S. Application Serial No. 10/027,787 and claims 1-22 of U.S. Application Serial No. 10/027,246. In response, Applicants enclose herewith as Appendix B two (2) terminal disclaimers signed by the assignee of record pursuant to 37 C.F.R. §1.321(c) and a certificate under 37 C.F.R. §3.73 establishing the right of such assignee to act with respect to this application.

Further, in the Office Action, independent claim 1 was also rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,017,931 to Golden. Golden is directed to a liquid-filled insole that defines a liquid-tight, liquid-filled envelope having three elements: (1) a pair of superposed plastic sheets secure to each other peripherally; (2) an internal functional design or pattern to form a plurality of non-communicating compartments between them; and (3) a liquid occupying the compartments. For example, Golden indicates that the bottom and top sheets may be made from vinyl or other thermoplastic sheets or films. Nevertheless, nowhere does Golden teach the use of a nonwoven web to form the disposable shoe insole. Applicants note that the use of such a nonwoven web is not merely a design choice, but instead may result in substantial improvements, such as providing enhanced comfort, facilitating elasticity, etc.

Independent claims 1 and 10 were also rejected in the Office Action under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,658,515 to Oatman. Oatman is directed to a laminated insole that is horizontally contoured to snugly insert within the shoe and be in intimate contact with the bottom of a foot. The laminate is formed from

three elements, i.e., a bottom sheet of flexible plastic material, a top sheet of similar flexible plastic material, and a spacer sheet bonded to the top and bottom sheets. The spacer sheet is formed from any number of foamed organic materials. (Col. 1, ll. 30-44). However, similar to Golden, Oatman also fails to teach the use of a nonwoven web to form the disposable shoe insole.

Finally, independent claims 1 and 10 were also rejected in the Office Action under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,753,357 to Filipitsch, et al. Filipitsch, et al. is directed to a moisture absorbent material. For example, as shown in Figs. 1-2, the moisture absorbent material may be used in an insole 10 that includes an upper layer 1 and a lower layer 2. The layers 1 and 2 are made from hydrophilic, moisture-permeable, elastic fabrics. The middle layer 3 of the insole 10 consists of space-filling unwoven fibrous material with granular material 6 even distributed among the fibers. The layers 1, 2, and 3 are connected to each other by sewing with a heavy-duty sewing machine. In another embodiment, as show in Figs. 3-4, the layer 3 is bonded to the layer 2 with an adhesive and sewn to layer 1. (Cols. 6-7).

Contrary to independent claims 1 and 10, however, Filipitsch, et al. completely fails to teach pockets containing discrete regions of a functional material. Specifically, in claims 1 and 10, the pockets are defined by unfused portions located between fused portions of the fused substrates. In Filipitsch, et al., the moisture absorbent material is connected to the other layers, such as by sewing or through an adhesive. Nevertheless, the granular material in the moisture absorbent materials is evenly distributed among the fibers of the layer. That is, it is not contained within "pockets" defined by unfused portions of substrates.

Thus, for at least the reasons set forth above, Applicants respectfully submit that independent claims 1 and 10 are not anticipated by the cited references. In addition, the cited references were also cited alone and/or combination to reject dependent claims 2-9 and 11-14. Applicants respectfully submit, however, that at least for the reasons indicated above relating to corresponding independent claims 1 and 10, claims 2-9 and 11-14 patentably define over the references cited. However, Applicants also note that the patentability of dependent claims 2-9 and 11-14 does not necessarily hinge on the patentability of independent claims 1 and 10. In particular, some or all of these claims may possess features that are independently patentable, regardless of the patentability of claims 1 and 10.

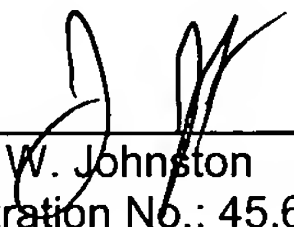
As such, for at least the reasons set forth above, Applicants respectfully submit that the present claims patentably define over all of the prior art of record. It is believed that the present application is in complete condition for allowance and favorable action, therefore, is respectfully requested. Examiner Loney is invited and encouraged to telephone the undersigned, however, should any issues remain after consideration of this response.

Please charge any additional fees required by this Amendment to Deposit Account No. 04-1403.

Appl. No. 10/029,132  
Amtd. dated Feb. 19, 2004  
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Respectfully submitted,

DORITY & MANNING, P.A.

  
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Jason W. Johnston  
Registration No.: 45,675

DORITY & MANNING, P.A.  
P.O. Box 1449  
Greenville, SC 29602-1449  
Phone: (864) 271-1592  
Facsimile: (864) 233-7342

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